

REMARKS

In the Office Action¹ of February 28, 2011 ("the Office Action"), the Examiner:

- (1) objected to the Specification as failing to provide proper antecedent basis for the claims;
- (2) rejected claims 1, 5-10, 25, 27, 30, 32-37, and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,424,438 to Vianello (*Vianello*) in view of U.S. Patent Application Publication No. 2001/0049674 to Talib et al. (*Talib*);
- (3) rejected claim 3, 14-16, and 18 under 35 U.S.C. § 103(a) over *Vianello* and *Talib* in view of U.S. Patent Application Publication No. 2005/0086204 to Coiera et al. (*Coiera*);
- (4) rejected claim 17 under 35 U.S.C. § 103(a) over *Vianello*, *Talib* and *Coiera* in view of U.S. Patent No. 6,636,837 to Nardozi et al. (*Nardozi*); and
- (5) rejected claims 19 and 20 under 35 U.S.C. § 103(a) over *Vianello*, *Talib* and *Coiera* in view of U.S. Patent No. 7,392,254 to Jenkins et al. (*Jenkins*);

By this Amendment, Applicant amend claims 1 and 25. Claims 2, 4, 11-13, 21-24, 26, 28, 29, 31 and 38 were canceled by previous amendment. Accordingly, upon entry of the above amendments, claims 1, 3, 5-10, 14-20, 25, 27, 30, 32-37, and 39-46 will remain pending in this application, including independent claims 1 and 25.

Applicant respectfully traverses the objection and rejections and submits that the pending claims are allowable over the prior art of record for at least the following reasons.

¹ The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

I. Objection to the Specification

On page 3 of the Office Action, the Examiner objected to the Specification, asserting that the specification fails to provide proper antecedent basis for the claimed subject matter "machine-readable storage medium." Applicant respectfully traverses this objection. However, in order to advance prosecution, Applicant has amended the Specification to further establish antecedent basis for the claimed "machine-readable storage medium." Accordingly, Applicant respectfully requests that the Examiner withdraw the objection to the Specification.

II. Rejection under 35 U.S.C. 103(a) Based on *Vianello* in view of *Talib*

Applicant respectfully traverses the rejection of claims 1, 5-10, 25, 270, 32-37, and 39-46 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello* in view of *Talib*. A *prima facie* case of obviousness has not been established with respect to Applicant's claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P.* § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art."

M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness has been established for at least the reasons that the Office Action has not properly determined the scope and content of the prior art and has not properly ascertained the differences between the claimed subject matter and the prior art.

Independent claim 1, as amended, is directed to a method which includes, among other things:

- automatically creating two or more segments of [a] narrowed hit-list by grouping the resources according to one of a plurality of attribute dimensions;

- generating, for the user, statistics associated with the segments;

- receiving a selection of two or more segments through the user interface; and

- providing, to the user, a subset of the narrowed hit-list based on the selected two or more segments.

In the Office Action, the Examiner concedes that *Vianello* does not disclose the above-noted claim language of claim 1, but asserts that *Talib* discloses these features of claim 1. This is incorrect.

Talib "relates to systems and methods for searching a data collection of employment information in such a manner that it is easy to search, drill down, drill-up, and drill across the data collection using multiple independent hierarchical category taxonomies of the data collection." See *Talib*, Abstract. In *Talib*, the user enters a search term and selects a taxonomy. See *Talib*, ¶ [0095]. "After selecting a taxonomy,

the user then selects a category 502.” *Id.* Categories comprise sub-categories, “[f]or instance, if the category 502 comprises ‘Finance,’ then the process might yield subcategories 503... [such as] ‘Leasing.’” *See Talib*, ¶ [0097].

In an example, a user searches for the term “tax” in the “Industry” taxonomy. *See Talib*, ¶¶ [0118],[0119]. The system then presents that 36,653 records have the word “tax” in them and determines categories for the records. *Id.* The user selects the “Finance” category presented by the system. *See Talib*, ¶ [0119]. The system generates sub-categories for the “Finance” category and displays that 254 records are organized into the “New Car Sales” sub-category and that 23,887 records are organized into the “Accounting” sub-category. *Id.* The user finally selects the sub-category “Accounting” and the system presents a list of the 23,887 records. *See Talib*, ¶¶ [0120],[0121].

However *Talib* does not teach or suggest “automatically creating two or more segments of [a] narrowed hit-list by grouping the resources according to one of a plurality of attribute dimensions” and “receiving a selection of **two or more segments** through the user interface,” as recited in amended claim 1 (emphasis added). This at least because the system of *Talib* merely allows the selection of a single category or sub-category at one time to “drill-down” a taxonomy. For example, *Talib* discloses selecting the “Accounting” sub-category under the “Finance” category, but does not allow for the selection of both the “Accounting” sub-category and the “New Car Sales” sub-category under the “Finance” category. Thus, even if the categorizing step of *Talib* were akin to the claimed “segmenting,” which it is not, and even if the sub-categories of

Talib were akin to the claimed “segments,” which they are not, *Talib* still fails to teach or suggest “receiving a selection of **two or more segments** through the user interface” as recited in claim 1 (emphasis added), since *Talib* only discloses the selection of a single sub-category for a given categorizing step. Moreover, *Talib* also fails to teach or suggest “providing, to the user, a subset of the narrowed hit-list **based on the selected two or more segments**,” as recited in amended claim 1 (emphasis added).

In view of the above, the Office Action has neither properly determined the scope and content of the prior art, nor ascertained the differences between the claimed subject matter and the prior art. Moreover, the Examiner has not identified any factors that would have motivated one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combination. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered independent claim 1 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to the claim and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Amended independent claim 25, while of different scope than independent claim 1, distinguishes over *Vianello* and *Talib* for at least reasons similar to those noted above for claim 1. Thus, the rejection of independent claim 25 under 35 U.S.C. § 103(a) should also be withdrawn for reasons similar to those set forth above for independent claim 1. Dependent claims 5-10, 25, 27, 30, 32-37, and 39-46 distinguish over *Vianello* and *Talib* at least due to their dependence from one of the allowable independent claims and further in view of the features recited in these claims.

Accordingly, Applicant requests reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection based on *Vianello* and *Talib* and the timely allowance of the claims.

III. Rejection under 35 U.S.C. 103(a) Based on *Vianello* and *Talib* in view of *Coiera*

Applicant respectfully traverses the rejection of claims 3, 14-16, and 18 under 35 U.S.C. § 103(a) over *Vianello* and *Talib* in view of *Coiera*. A *prima facie* case of obviousness has not been established with respect to claims 3, 14-16, and 18.

Dependent claims 3, 14-16, and 18 depend from allowable independent claim 1 and includes all recitations therein. As discussed, combinations of *Vianello* and *Talib* fail to teach or suggest all of the features of independent claim 1. *Coiera* fails to remedy the deficiencies of *Vianello* and *Talib* at least because *Coiera* also fails to teach or suggest the above noted features of claim 1. Accordingly, combinations of *Vianello*, *Talib*, and *Coiera* fail to teach or suggest dependent claims 3, 14-16, and 18, and these claims allowable at least because of their dependence from claim 1, as well as in view of the additional features recited in these claims.

IV. Rejections under 35 U.S.C. 103(a) Based on *Vianello*, *Talib* and *Coiera* in view of *Nardozzi*

Applicant respectfully traverses the rejection of claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello*, *Talib*, and *Coiera* in view of *Nardozzi*. A *prima facie* case of obviousness has not been established with respect to claim 17.

Dependent claim 17 depends from allowable independent claim 1 and includes all recitations therein. As discussed, combinations of *Vianello*, *Talib*, and *Coiera* fail to teach or suggest all of the features of claim 1. *Nardozzi* fails to remedy the deficiencies

of *Vianello, Talib, and Coiera* at least because *Nardozzi* also fails to teach or suggest the above noted features of claim 1. Accordingly, combinations of *Vianello, Talib, Coiera, and Nardozzi* fail to teach or suggest dependent claim 17, and this claim is allowable at least because of its dependence from claim 1, as well as in view of the additional features recited by this claim.

V. Rejections under 35 U.S.C. 103(a) Based on *Vianello, Talib and Coiera* in view of *Jenkins*

Applicant respectfully traverses the rejection of claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Vianello, Talib, and Coiera* in view of *Jenkins*. A *prima facie* case of obviousness has not been established with respect to claims 19 and 20.

Dependent claims 19 and 20 depend from allowable independent claim 1 and include all recitations therein. As discussed, combinations of *Vianello, Talib, and Coiera* fail to teach or suggest all of the features of claim 1. *Jenkins* fails to remedy the deficiencies of *Vianello, Talib, and Coiera* at least because *Jenkins* also fails to teach or suggest the above noted features of claim 1. Accordingly, combinations of *Vianello, Talib, Coiera, and Jenkins* fail to teach or suggest dependent claims 19 and 20, and these claims are allowable at least because of their dependence from claim 1, as well as in view of the additional features recited by these claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Philip J. Hoffmann
Reg. No. 46,340
(202) 408-4398

Dated: May 31, 2011